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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,000	06/25/2003	Sean E. Aschen	END920030033US1	4746
26502	7590	12/07/2005	EXAMINER	
IBM CORPORATION IPLAW IQ0A/40-3 1701 NORTH STREET ENDICOTT, NY 13760			AHN, SANGWOO	
			ART UNIT	PAPER NUMBER
			2166	

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/604,000	Applicant(s) ASCHEN ET AL.	
	Examiner Sangwoo Ahn	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>06252003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 10 is objected to because of the following informalities:

The claim recites, "...upon return converting said one of said documents..." in line 5. There is either a grammatical or a typological error in this phrase. Examiner suggests the applicant to fix and clarify this limitation.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 – 4, 6 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication Number 2002/0091782 issued to Benninghoff III ("Benninghoff") in view of U.S. Patent Number 5,913,033 issued to Grout ("Grout").

With respect to claim 1, Benninghoff discloses,

A method of providing data to an application, comprising the steps of:

providing a mailfile of documents having a section and fields (Figure 2 – 3, 7, and paragraph 12, 134);

receiving a request from an application for one of said documents (Figure 5, 19, and paragraph 134);

retrieving said fields of said one of said documents from said mailfile (Figure 5, 11, and paragraph 134);

in response to said fields, retrieving said one of said documents as a markup language document (paragraph 10 – 12, 134);

sending said object to said application (paragraph 9 – 12, 134).

Benninghoff does not explicitly disclose\$,

inserting a URL into said markup language document to retrieve said section of said one of said documents;

retrieving said section from said mailfile in said markup language;

removing said URL from the retrieved document.

However, Grout discloses,

inserting a URL into said markup language document to retrieve said section of said one of said documents (Figure 2A, column 3 line 13 – 32, column 6 line 60 – 63);

retrieving said section from said mailfile in said markup language (Figure 2A, column 3 line 13 – 32);

removing said URL from the retrieved document and creating an object having said section expanded in the retrieved document (Figure 2A, column 5 line 45 – 61).

At the time of the present invention, it would have been obvious to a person of ordinary skill in the data processing art to combine the two references because Grout's method of inserting a URL and retrieving the designated section to replace the URL would have enabled Benninghoff's method of providing data to an application to

increase the performance of browsing documents and allows downloading of multimedia objects tailored for the user's language or culture (column 2 line 59 – 64).

With respect to claim 2, Benninghoff discloses said fields are retrieved as an XML document (paragraph 10 – 12, 134).

With respect to claim 3, Grout discloses said markup language is HTML (column 5 line 45 – 61, column 6 line 60 to column 7 line 45)

With respect to claim 4, Benninghoff discloses said one of said documents has a file attachment link (Figure 3 – 4, 7).

With respect to claim 6, Grout discloses said one of said documents has an image tag (column 7 line 1 – 44).

With respect to claim 7, Grout discloses retrieving the image of said image tag, encoding said image, and inserting the encoded image in place of said image tag in the retrieved document (Figure 2A, column 6 line 60 to column 7 line 45).

With respect to claim 8, Grout discloses said one of said documents has a link to other items in said document (Figure 2A, column 3 line 13 – 32).

With respect to claim 9, Grout discloses retrieving the content of said link, and inserting said content in the retrieved document at the position of said link (Figure 2A, column 6 line 60 to column 7 line 45).

With respect to claim 10, Benninghoff discloses,

A system for providing data stored in a mailfile to an application, comprising:

a mailfile having data stored as documents with sections (Figure 2 – 3, 7, and paragraph 12, 134);

a database for passing a request for one of said documents to said mailfile and upon return converting said one of said documents into an extended markup format (Figure 5, 11, 19, and paragraph 10 – 12, 134);

an authentication directory having authentication records for an application (Figure 5, 12, and paragraph 14, 43, 46, 55, 131); and

mail and calendaring web service (paragraph 134: eml file's program and/or extension function is outlook express electronic mail. It is well known that outlook is a mail and calendaring software) software for receiving a request from an application for a document (Figure 5, 19, and paragraph 134), receiving text files in an extended markup format from said database, accessing binary data from said mailfile, creating an object comprising the converted document with said binary data inserted (Figure 5, 11, paragraph 10 – 12, 134), authenticating said application using said directory (Figure 5, 12, and paragraph 14, 43, 46, 55, 131), and sending said object to said application (paragraph 9 – 12, 134).

With respect to claim 11, Benninghoff discloses said database and said software run on different servers (Figure 1)

With respect to claim 12, Benninghoff discloses said extended markup format is XML (paragraph 10 – 12, 134).

With respect to claim 13, Benninghoff discloses said software is adapted to operate without the need of a mail or calendaring client (Figure 1, paragraph 9).

With respect to claim 14, Benninghoff discloses said software is adapted to retrieve said sections of said document from said mailfile (Figure 2 – 3, 5, 7, and paragraph 11 – 12, 134).

With respect to claim 15, Benninghoff discloses said binary data is an image file (Figure 2 – 3, 5, 7: attachment could be an image file).

Claim 16 – 18 are essentially the same as claim 1 – 3 except they set forth the limitations as “a computer system for exposing a mail and calendaring document to an application” rather than “a method of providing data to an application”, and therefore are rejected for the same reasons as discussed in claim 1 – 3 rejections.

Claim 19 – 20 are essentially the same as claim 1 – 2 except they set forth the limitations as “a computer product” rather than “a method”, and therefore are rejected for the same reasons as discussed in claim 1 – 2 rejections.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benninghoff and Grout, further in view of U.S. Publication Number 2005/0114671 issued to Little et al (“Little”).

Benninghoff and Grout discloses the method of claim 4 as discussed above in claim 4 rejection.

Benninghoff and Grout do not explicitly indicate retrieving attachment, removing said link, and inserting said attachment into said object.

However, Little discloses retrieving attachment, removing said link, and inserting said attachment into said object (paragraph 76). At the time of the present invention, it would have been obvious to a person of ordinary skill in the data processing art to

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combine the aforementioned references because Little's method of embedding the attachment into the body of the email message would have enabled Benninghoff and Grout's method of providing data to an application to save user's effort and time needed to open and store the attachment, by already displaying the attachment within the body of the email message.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Number 6,424,995 issued to Shuman discloses a method for displaying information contained in an electronic message.

U.S. Patent Number 6,859,213 issued to Carter discloses a method for selecting attachments.

U.S. Publication Number 2003/0120737 issued to Lytle et al. discloses a method for composing, processing, and organizing electronic mail message items.

U.S. Publication Number 2002/0133633 issued to Kumar discloses management of links, such as URLs or other link formats that have been embedded within blocks of data, such as data received by an e-mail application program.

U.S. Publication Number 2004/0183830 issued to Cody et al. discloses a dynamic-template incorporation of digital images in an electronic mail message.

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sangwoo Ahn whose telephone number is (571) 272-5626. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sangwoo Ahn
Patent Examiner
Art Unit 2166

12/05/2005 SW


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER